

## **REMARKS**

### **Present Application**

Claims 10, 12, 13, 15 - 22, 25, 27 - 30, and 31 - 32 are now in this application. Claims 23 and 24 have been cancelled herein without prejudice. Cancellation of claims as filed should not be construed in any manner to restrict Applicant's right to pursue such claims, or the subject matter thereof, in this application or any application claiming priority from this application, or in any reissue, reexamination or similar application which may be filed with respect thereto. Claims 15 - 22, 25 and 27 - 30 have been amended. Amendment of the claims should not be construed in any matter to restrict Applicant's right to pursue the subject matter asserted by the unamended claims in this application or any application claiming priority from this application, or in any reissue, reexamination or similar application which may be filed with respect thereto. Claims 31 and 32 have been added. Support for claims 31 and 32 is found, among other places, at pages 11 - 12.

## **OBJECTIONS**

### **The Claims**

The Examiner has objected to claim 29 in that it lacks proper non-verb agreement (Paragraph 5, Page 2, of the Office Action). Applicants have amended the claim to overcome such informality.

## **REJECTIONS**

### **35 U.S.C. § 101**

The Examiner has rejected claims 23 and 24 under 35 U.S.C. § 101 “because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process” (Paragraph 7, Page 2, of the Office Action). While Applicants traverse such rejection (asserting such claims to be proper), as Applicants have herein cancelled claims 23 and 24, without prejudice, Applicants assert that such rejection is mooted.

### **35 U.S.C. § 112, Second Paragraph**

The Examiner has further rejected claims 15 - 22,, 23 - 24 and 27 - 30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which is asserted (Paragraph 9, Page 3, of the Office Action). Applicants respectfully traverse such rejections, asserting that the claims when taken as a whole would be found by a person of ordinary skill in the art to distinctly point out and claim the subject matter asserted.

With respect to claims 23 and 24, the Examiner asserts that as the claim does not set forth any steps involved in the method/process that “it is unclear what method/process applicant is intending to encompass” (Paragraph 9b, Page 3, of the Office

Action). Applicants, once more, assert that such rejections are mooted given the fact that such claims have been cancelled herein, without prejudice.

With respect to claims 15 - 22, the Examiner asserts that the claims are indefinite in the recitation "from the Sequence Listing" as such recitation is confusing and superfluous" (Paragraph 9a, Page 3, of the Office Action). In accord with the Examiner's suggestion, the claims have been amended to remove "from the Sequence Listing." It is therefore asserted that such rejection have been overcome.

With respect to claims 27 - 30, the Examiner asserts that the same are indefinite in reciting "detects azole derivative-resistant cells" because "azole derivative" lacks proper antecedent basis in the preamble of the claims (Paragraph 9c, Page 4, of the Office Action). Once more, in accord with the Examiner's suggestion, the claims have been amended to provide what is believed to be proper antecedent basis. It is therefore asserted that such rejection has been overcome.

### **35 U.S.C. § 103**

Claims 10, 12 - 24 and 27 - 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over the "White reference" (Antimicrobial Agents & Chemotherapy, July 1997, 41(7): 1488 - 1494) in view of the "Lai *et al.* reference" (Nucleic Acids Research 1989, 17(2): 804). Applicants respectfully traverse such rejection arguing that when the claims are read as a whole that one of ordinary skill in the art would not find the asserted subject matter to be obvious in light of the prior art of record.

The Examiner asserts pointing to the Lai *et al.* reference that the nucleic acid sequence of the EFG 16 gene was known in the art prior to the application, and that it was known that *Candida albicans* is a major fungal pathogen in humans (Paragraph 11, Page 5, of the Office Action). The Examiner further asserts that there was a reasonable expectation of success that primers and probes could be made to this gene given the teachings of the White reference.

The White reference is characterized by the Examiner as teaching nucleic acid probes and primers comprising overlapping regions of the entire ERG 16 coding region, and teaches how to make and use such primers and probes for amplifying and detecting specific regions of the ERG 16 gene. The Examiner asserts that "the skilled practitioner would have been motivated to detect other regions of the ERG 16 gene by PCR amplification followed by probe detection for the expected benefit of identifying azole-resistant fungal pathogens in a clinical sample in view of the White teaching that azole resistance in the *C. albicans* is an emerging problem in the HIV-infected population (*Id.*).

Claim 25 directed to a kit is said to be further unpatentable over the White reference in view of the Stratagene catalogue of 1988. The Examiner asserts that while the White reference does not teach reagents combined into a kit, the Stratagene catalog would motivate one to do so (Paragraph 12, Page 6, of the Office Action). Applicants disagree.

Applicants note that the Examiner's 35 U.S.C. § 103 arguments are based considerably on the teachings of the White reference. Applicants point out, however, that the White reference is not prior art with respect to the present application. Applicants herein supply a translation of the priority application from which the present application derives. Applicant notes that such German Patent Application pre-dates the White reference by about nine months. Applicants therefore respectfully urge that the Examiner's 103 rejections based on White be withdrawn.

### **CONCLUSION**

It is respectfully submitted that allowance of this application is in order. Favorable action is earnestly and respectfully requested, and a notice of allowance is urged to be issued with respect to pending claims 10, 12, 13, 15 - 22, 25, 27 - 30, and 31 - 32.

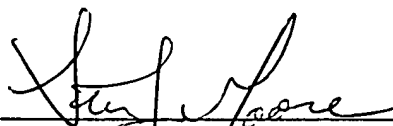
### **FEES**

All fees believed to be due with respect to the filing of this continuation application and this amendment are enclosed. The Assistant Commissioner, however, is

authorized to charge payment of any fees that may be required 37 C.F.R. §1.16 in connection with the paper(s) transmitted herewith, or credit any overpayment of the same, to Deposit Account No. 11-0231.

Respectfully submitted,

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